REMARKS

Presently, claims 1-10, 12-18, 60 and 62-103 are pending in the application. A Request for Continued Examination ("RCE") under 37 C.F.R. §1.114 is being filed herewith. Claims 1, 12, 13, 60, 66, 67, 79, 84 and 85 have been amended. New claims 94-103 have been added. Support for the amendments to claims 1, 12, 13, 60, 66, 67, 79, 84 and 85 may be found, for example, in Figs. 3, 5A and 5B and at page 13, line 20 – page 14, line 15 and at page 25, line 1 – page 26, line 15 of the specification. Support for the features of new independent claim 97 may be found, for example, in previously presented claim 60. Support for the features of new dependent claims 94-96 may be found, for example, in previously presented independent claims 1, 60 and 79, respectively. Support for the features of new dependent claims 98-104 may be found, for example, in previously presented dependent claims 62-64, 66, 67 and 78, respectively. Accordingly, no new matter has been added to the application by the foregoing amendments.

A description of the prior art references discussed herein may be found in Applicants' Amendment Accompanying RCE, filed August 22, 2005, and Applicants' Amendment, filed March 2, 2006, both of which are incorporated herein by reference.

Prior Art Rejections – § 103(a)

The Examiner has rejected claims 1, 2, 7, 8, 10, 12-18 and 60 and 62-93 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond") in view of U.S. Patent No. 6,119,098 to Guyot *et al.* ("Guyot") and further in view of U.S. Patent Publication No. 2003/0200128 A1 Doherty ("Doherty"). The Examiner contends that Zigmond teaches all features of the claimed invention with the exception of a queue having an ordered list of advertisement resource locators ("ARLs"), retrieving an ARL from the queue in accordance with the ordered list and sold queue locations that at least partially determine the order of the ARLs in the ordered list. The Examiner further contends that Guyot and Doherty teach these features, and

concludes that it would have been obvious to modify Zigmond's system to include a queue having an ordered list having sold locations that determine the order of the ARLs in the ordered list as taught by Guyot and Doherty, resulting in Applicants' claimed invention. In view of the foregoing amendments, Applicants respectfully traverse this rejection.

Independent claim 1, as amended, recites, in relevant part:

> A method of selectively inserting advertisements into a programming stream at different receiving nodes of a communications network, said method comprising:
>
> (a) transmitting the programming stream from a central location to one or more receiving nodes;
>
> (b) storing advertisements at a node of said network...;
>
> (c) storing one or more queues...said queues comprising an ordered list of advertisement resource locators (ARLs) and a plurality of queue slots...;
>
> (d) selling specific queue slots, wherein the sold specific queue slots at least partially determine the order of the ARLs in said ordered list;
>
> (e) determining, at each of said receiving nodes, one or more intervals in said programming stream within which advertisements may be inserted;
>
> (f) responsive to said determination, retrieving from said queue corresponding to said receiving node one of said ARLs in accordance with said ordered list; and
>
> (g) inserting said advertisement corresponding to said retrieved ARL into said programming stream.... (emphasis added)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. *See* MPEP 2143.

1. The Combination of References Does Not Teach or Suggest All Claim Elements

Applicants respectfully submit that the combination of Zigmond, Guyot and Doherty, even if proper, fails to teach or suggest all of the features of independent claim 1. In particular, Applicants respectfully disagree with the Examiner's assertion that Zigmond teaches "selling locations in said queues," as discussed in the previous Amendment. However, to further prosecution of the present application, Applicants have amended independent claim 1 to recite "selling specific queue slots, wherein the sold specific queue slots at least partially determine the order of the ARLs in said ordered list."

In the Office Action, the Examiner points to column 8, lines 22-29 of Zigmond (see page 3 of the Office Action), which sates:

> In another embodiment, a third party advertisement content provider makes the advertisements available to the advertisement source 62 and the ad insertion device 60. In this case, the third party advertisement content provider typically contracts with the advertisers to provide a predetermined type or number of advertisement exposures for the advertisers.

As previously explained in Applicants' Amendment filed on March 2, 2006, this portion of Zigmond does not teach or suggest that specific queue slots are sold to advertisers. That is, Zigmond merely teaches that there may be a contractual relationship between the content provider and the advertisers, such that the advertisers have an agreed-upon number of advertisement opportunities for their ads, or that advertisers pay an agreed-upon price to display their ads, or that the advertiser's ads are displayed during a particular time period. Thus, although Zigmond's system operates using the traditional concept of selling particular ad space in a program stream to advertisers, Zigmond does not teach that specific queue slots are sold. That is, in independent claim 1, the queues

comprise a plurality of queue slots and specific queue slots are sold, thereby enabling advertisers to purchase one or more specific queue slots in a queue.

Moreover, independent claim 1 recites that "the sold specific queue slots at least partially determine the order of the ARLs in said ordered list." That is, in independent claim 1, the order in which the ARLs (or advertisements) are arranged within the queue is partially dependent on which specific queue slot was sold for that advertisement. Zigmond does not teach or suggest such a concept. As such, Zigmond does not teach or suggest the features of independent claim 1 as contended by the Examiner.

Similarly, Guyot also does not teach or suggest "selling specific queue slots, wherein the sold specific queue slots at least partially determine the order of the ARLs in said ordered list." Although Guyot teaches a queue of targeted ads that specifies (to some degree) the order in which those ads are displayed to the user, there is no teaching in Guyot that any of the queue slots are sold to advertisers. Rather, similar to Zigmond, Guyot teaches that advertisements include certain criteria, such as the number of times an advertisement may be displayed, certain time periods during which an ad may be displayed, or whether an ad is a "screen saver" ad. In Guyot, advertisers are billed based on advertisements that are displayed to users. Thus, Guyot does not teach or suggest that specific queue slots are sold. Guyot therefore, does also not teach or suggest that "the sold specific queue slots at least partially determine the order of the ARLs in said ordered list," as recited in independent claim 1.

Similarly, assuming arguendo, that Doherty's system teaches utilizing an "order" or "queue" for the insertion of advertisements, Doherty certainly does not teach or suggest selling specific queue slots. In traditional ad display schemes (such as Doherty), it is the ad space that is sold – not specific queue slots or locations. Accordingly, Doherty does not teach or suggest this feature of independent claim 1.

In view of the foregoing, the combination of Zigmond, Guyot and Doherty, even if proper, fails to teach or suggest all of the features of claim 1. Specifically, the combination of Zigmond, Guyot and Doherty does not teach or suggest "selling specific queue slots, wherein the sold specific queue slots at least partially determine the order of the ARLs in said ordered list." As discussed above, none of the applied references

18

teaches this feature. Thus, the combination of Zigmond, Guyot and Doherty is also lacking at least this feature.

2. No Motivation to Combine the References

Applicants also respectfully submit that the Examiner has not pointed to, nor is there, an objective teaching in Zigmond, Goyot, Doherty or in the knowledge generally available to one of ordinary skill in the art that suggests the desirability of combining these references. The Examiner has merely suggested that one of ordinary skill in the art would combine Guyot and/or Doherty with Zigmond to "better control the output and updating of advertisements," and "allowing the system provider additional revenue while allowing advertisers to control the display of their advertisement as desired" (see page 4 of the Office Action). However, such a teaching or motivation is not found in any of the references. Merely pointing out the existence of particular teachings in one reference is not sufficient to establish that there would be a motivation to combine that reference with another. The burden is on the Examiner to provide a convincing line of reasoning, based on knowledge generally available to one of ordinary skill in the art, established scientific principles or legal precedent, that there would have been a motivation to combine Zigmond and Doherty. *See* MPEP 2144.

Moreover, there is no suggestion or any objective teaching in Zigmond to suggest the addition of an ordered list or queue to Zigmond's system, nor would one skilled in the art necessarily think to add a schedule or queue to Zigmond's system, as taught by Doherty or Guyot. Zigmond's system does not need nor contemplate the need for an ordered list or queue of advertisements. Zigmond's system also already has the ability to select the desired advertisement(s) "on demand", thereby obviating the need for a schedule or queue as suggested by the Examiner. Furthermore, one skilled in the art would not be motivated to combine the teachings of Guyot with the system taught by Zigmond. That is, the targeted advertisements in Guyot are not inserted into any type of program stream, whereas Zigmond's system inserts advertisements into program streams. Since the prior art does not suggest the desirability of such a modification (within the prior art itself), the Examiner has not satisfied this requirement of establishing a *prima*

facie case of obviousness. Accordingly, Applicants respectfully submit that the proposed combination of Zigmond, Guyot and Doherty is improper.

Applicants respectfully submit that the Examiner has not met the burden of *prima facie* obviousness, since the Examiner has not pointed to an objective teaching which suggests the motivation to combine the references. Furthermore, even assuming that the references are properly combinable, not all of the features of Applicants' claimed invention would be taught. Thus, independent claim 1 is believed to be allowable over the combination of Zigmond, Guyot and Doherty.

Independent claims 60 and 79 recite "selling specific queue slots, wherein the sold specific queue slots at least partially determine the ordered list of the advertisements within the queues."

New independent claim 97 recites, "a plurality of queue locations forming an ordered list of advertisements...; selling one or more specific individual queue locations, wherein the sold specific individual queue locations at least partially determine the ordered list of the advertisements within the queues..."

For the same reasons discussed above with respect to independent claim 1, the combination of Zigmond, Guyot and Doherty does not teach or suggest all of the elements of independent claims 60, 79 and 97. Accordingly, independent claims 60, 79 and 97 are believed to be allowable over Zigmond, Guyot and Doherty, both individually and in combination.

Dependent claims 2, 7, 8, 10, 12-18, 62-78, 80-96 and 98-103 are allowable at least by their dependency on their respective independent claims 1, 60, 79 and 97. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 1, 2, 7, 8, 10, 12-18, 60 and 62-93 over Zigmond in view of Guyot and Doherty are respectfully requested.

The Examiner has rejected claims 3-6 and 9 as being unpatentable over Zigmond, Guyot and Doherty, and further in view of U. S. Patent No. 6,505,169 to Bhagavath *et al.* ("Bhagavath"). As discussed above with respect to the Examiner's obviousness rejection

over Zigmond, Guyot and Doherty, independent claim 1 is believed to be allowable over the combination of Zigmond, Guyot and Doherty. Applicants respectfully submit that Bhagavath does not teach or suggest any of the elements missing from such combination. Thus, independent claim 1 is believed to be allowable over the combination of Zigmond, Guyot, Doherty and Bhagavath. Accordingly, claims 3-6 and 9 are allowable at least by their dependency on independent claim 1. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 3-6 and 9 over Zigmond, Guyot, Doherty and Bhagavath are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 1-10, 12-18, 60 and 62-103, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: ___9/22/06___   By: _____
                                  Andrew W. Spicer
                                  Registration No. 57,420
                                  Technology, Patents, & Licensing, Inc.
                                  2003 South Easton Road
                                  Suite 208
                                  Doylestown, PA 18901
                                  Telephone: 267-880-1720
                                  Customer No.: 27832